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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,589	12/26/2001	Seiji Ohno	217577US0CONT	9443

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 01/31/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025589

Applicant(s)

Ohno et al

Examiner

J. M. Ford

Group Art Unit

1624

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on Dec 5, 2002
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11, 14-22, 26 and 31-41 is/are pending in the application.
- Of the above claim(s) 31-39 and 41 is/are withdrawn from consideration.
- ☒ Claim(s) 22 is/are allowed.
- ☒ Claim(s) 1-11, 14-21, 26 and 40 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

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Applicants' response of Dec. 05, 2002, is noted.

The claims in the application are claims 1--11, 14--22, 26 and 31--41.

Claims 1--11, 14--22, 26 and 40 are the elected subject matter.

Claims 31--39 and 41 stand withdrawn, as being directed to non elected subject matter.

Applicants have not written elected claim 38 in independent form, so it cannot be included in the elected invention.

Claim 33 is too vague to be considered an adequate utility statement. See the last Office Action.

No copy of PCT/JP00/04107 is found in the file. So priority cannot be granted, as there is a hiatus in the continuity.

No statement that this is a continuation of PCT/JP00/04107 appears on page 1 of the specification, at the top of the page.

Applicants are not entitled to priority, at all, as it is more than a year between the Japanese 11-177493 of 06/23/1999 and the instant filing date.

The present application 10/025589 is said to be a continuation of PCT/JP00/04107, not a 371.

This means the date of the application is its filing date. The art of record applies.

Claim 1 is very hard to understand. C is not carbon in formula 1.

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Applicants are entitled to be their own lexicographer up to the point that they assign a meaning to a letter or term that already has a recognized chemical (IUPAC) meaning, B, and D, are bad, but C goes too far.

On page 2 of claim 1 “wherein B1 represents hydrogen atom, a lower alkyl group which optionally contains a hetero atom in the chain thereof, a lower alkylcarbonyl group, only when L represents oxygen.”

What is B1 the rest of the time?

The last line of page 2 of claim 1 reads: “or a group of the following formula (3) or (4):”

What is or a group of the formula (3) or (4)? Is it an E or a Y or a B1?

At the top of page 3 of claim 1 we find: “a substituted phenyl ’ or “a substituted heteroaryl group.” The question becomes what are the substituents? Turn the page and at the top of page 4 one finds: “substituents in the substituted phenyl, pyridyl, furyl and thienyl groups are those described later with reference to R1 to R5 in general formula (2), L must be oxygen atom, Y must be an interatomic bond and E must be hydrogen atom;” Ok, but why must L be oxygen, Y a bond, and E=hydrogen?

What is that about? Is art being written around? What art? See Rule 105 (amended)

On page 5 one finds: C represents hydrogen atom, a lower alkyl group, a hydroxy-lower alkyl group, a benzyl group, a pyridylmethyl group, an amino-lower alkyl group or a carboxy-lower alkyl group;

C represents carbon.

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The claim is full of inserts, asides. On page 8 only when Z represents Z1" or "only when L represents oxygen.

These constant inserts leave one with little to no understanding of what is being claimed.

Accordingly, claim 1 is rejected under 35 U.S.C. 112, 2nd paragraph, as not understandable.

Claim 1 et seq. (those noted as the elected subject matter) are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent 6,172,066. Compare the claims.

It is so hard to read claim 1. I cannot tell what L is, or B1, or Y, or E. The bottom of page 2 seems to be a proviso, not a straight forward statement. When does B1 end? What are formula 3 or 4 as the top of page 3?

Is L ever N? Is E ever a hetero ring? See U.S. Patent 6,339,090.

When B2 is pyridine appears to be in U.S. Patent 6,436,943.

A rejection is not made as I do not know what kind of date applicants are going to establish, and there is no certainty as to what claim 1 says.

U.S. Patent 6,320,049 is of interest.

Claims 2--11, 14--21, 26 and 40 are rejected as being dependent on claim 1 a rejected claim.

It is not seen in claim 1 where L is said to be N-F, quite often said in the dependent claims. basis: Rule 75 (d) (1).²

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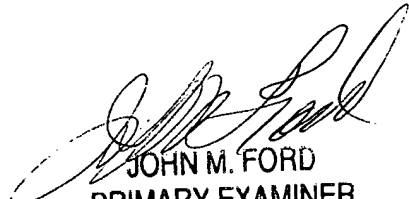
Page 8 is noted, but that is a proviso, not a direct statement. Everything seems to be in the past tense rather than the present tense. There is no antecedent basis, for \angle to be $>N-F$. Rule 75(d) (1).

F cannot be hydrogen. Page 8, F is fluoro.

What is structure 8 on page 8 of claim 1? Is it a Y, or an L or an E? Everything is a proviso, with no antecedent basis.

John M. Ford:jmr

January 24, 2003


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624